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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,060	01/17/2001	Baofa Yu	494492000100	7710

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EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 05/30/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/765,060

Applicant(s)
Yu

Examiner
Karen Canella

Art Unit
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Acknowledgment is made of applicant's election, with traverse, of Group X, drawn to a method of treating a neoplasm in an animal. The traversal is on the ground that the restriction is improper as it separates inventions having a "unifying feature" and further, that all the claims in Groups I through XX can be searched under the same class of 424 and subclass of 278.1. This has been considered and found partially persuasive. A search under class 424, subclass 278.1 would not be comprehensive for all the pending claims, as can be seen by the multiple classes and subclasses designated for each Group I through XX in the previous restriction requirement. As to the question of burden of search, the literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Clearly different searches and issues are involved in the examination of each group. Upon review and reconsideration, the methods of Groups XI to XX will be joined to the elected method of Group X, (now comprising claims 36-77 and 79). Claims 1-35, and 78 drawn to a combination of products, a kit and an article of manufacture comprising said product, will be rejoined into a single product Group, but will not be rejoined to the elected method Group, as the inventions of claims 1-35 and 78 are related to the elected method Group as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products of claims 1, 3 and 6-9 can be used in an in vitro assay as evidenced by the abstract of Pan et al (Cancer Research, 1989, Vol. 49, pp. 5048-5053). Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

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Election/Restriction

2. Claim 36 is generic to a plurality of disclosed patentably distinct species comprising:

- (A) the haptens recited in claim 38,
- (B) the chelators recited in claim 41,
- (C) the immune response potentiators recited in claim 44,
- (D) the enzymes recited in claim 45,
- (E) the coagulation lysing agents recited in claim 48,
- (F) the oxidizing agents recited in claim 51,
- (G) the reducing agents recited in claim 52,
- (H) the protein denaturing agents recited in claim 54,
- (I) the alcohols recited in claim 55,
- (J) the anti-angiogenic agents recited in claims 59 and 60,
- (K) the anti-neoplasm agents recited in claim 61,
- (L) the oncogenes recited in claim 64,
- (M) the tumor suppressor genes recited in claim 65,
- (N) the coagulation treatments recited in claim 70,
- (O) the neoplasms recited in claim 72 , and
- (P) the molecules recited in claim 79.

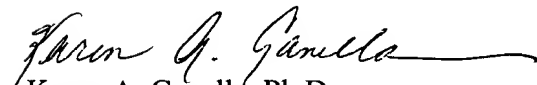
Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each of the groups (A) through (P), even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

May 20, 2002